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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,614	07/19/2000	Makoto Kukita	193236US2	2165

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EXAMINER

SHENG, TOM V

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/619,614

Applicant(s)

KUKITA, MAKOTO

Examiner

Tom V Sheng

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-11 and 13 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 12 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 8-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stiles (US Patent 5402150).

Consider claim 1. Stiles teaches a pivotable trackball-type pointing device that removably attaches to a computer. The pointing device attaches to a keyboard, a laptop, or a desktop (column 1 lines 5-9). Further, Stiles describes broader applications (column 4 lines 14-27).

Stiles' preferred embodiment is a trackball (figure 5A); nevertheless, he states that his invention may be used with any input or peripheral devices usable with a computer (column 4 lines 3-5).

Stiles is silent on the use of the pointing device as also a holding unit, but this does not prevent it being used as such, especially when the housing of the pointing device can fit one's hand. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make Stiles' invention fits a hand comfortably and usable as a holding unit of a portable electronic apparatus, providing versatility in handling.

Claim 2 is similarly analyzed as claim 1. Stiles' invention includes all input or peripheral devices.

Claim 3 is similarly analyzed as claim 1. Stiles' trackball includes input buttons (column 4 lines 36-37).

Claim 4 is similarly analyzed as claim 1. Stiles' pointing device is removable.

Claim 6 is similarly analyzed as claim 1. Stiles' pointing device is pivotable.

Claims 8, 10 are similarly analyzed as claims 1 and 3.

Claim 9 is similarly analyzed as claims 1, 2, and 3.

Claim 11 is similarly analyzed as claims 1, 3, and 4.

Claim 13 is similarly analyzed as claims 1, 3, and 6.

### ***Allowable Subject Matter***

3. Claims 5, 7, 12, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rossmann et al. (US Patent 4415250) teaches a detachable focusing system for long focal length objectives, which also supports the objectives.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

TS  
May 30, 2002

  
**KENT CHANG**  
**PRIMARY EXAMINER**